

REMARKS

Claims 1-30 are pending in the Application. Claims 28-30 have been added. The Specification has been amended to correct typographical errors. No new matter has been added. Entry of the amendment is respectfully requested. Reconsideration is respectfully requested.

Priority

A priority statement has been added to the Specification, as requested by the Office. Please substitute the above priority statement in place of any previously entered priority statement (e.g., amendment in the transmittal papers filed 11/17/1998).

Information Disclosure Statement

The Action indicates that the Information Disclosure Statement ("IDS") submitted May 14, 2001 was not considered because it failed to comply with 37 CFR 1.98(a)(2). The Applicants disagree. No other reason for lack of consideration was provided in the Action.

37 CFR 1.98(a)(2) pertains to the IDS including a copy of the information. However, 37 CFR 1.98(d) states that a copy of the information is not required to be provided if it was previously cited by or submitted to the Office in a prior application which was identified in the IDS and is relied on under 35 U.S.C. § 120. Since the needed criteria has been met, no copies of the documents were required to be provided. The submitted IDS already explained why the documents were not being provided with reference to 37 CFR 1.98(d). Furthermore, if necessary, note MPEP § 609 (i.e., MPEP version August 2001; page 600-121; last paragraph).

The IDS submitted May 14, 2001 included two pages of form PTO-1449. It is noted that the information listed on page 1 was initialed by the Examiner and indicated as considered. The information listed on page 2 was not initialed by the Examiner but was crossed through. However, the page 2 information was indicated as considered.

In light of Applicants' above comments, it is respectfully requested that the IDS be properly entered and fully considered. Attached is a clean copy of said page 2.

The Drawings

The drawings have been amended as shown in the corresponding Request to Amend Drawings. Formal drawings have been submitted. The drawings are in compliance with 37 CFR 1.84. Applicants respectfully request that the objection to the drawings be withdrawn.

The 35 U.S.C. § 103 Rejections

For brevity the Applicants have not necessarily presented all the reasons as to why the applied references do not render the claims obvious. Applicants reserve the right to later present additional reasons. Nevertheless, Applicants' arguments show that the applied references do not disclose or suggest all of the steps, features, and relationships of the claimed invention. Hence, Applicants' claims patentably distinguish over the applied references. Therefore, it is respectfully submitted that the 35 U.S.C. § 103(a) rejections should be withdrawn.

The Legal Standard

Before a claim may be rejected on the basis of obviousness pursuant to 35 U.S.C. § 103, the Patent Office bears the burden of establishing that all the recited features of the claim are known in the prior art. This is known as *prima facie obviousness*. To establish *prima facie* obviousness, it must be shown that all the elements and relationships recited in the claim are known in the prior art. If the Office does not produce a *prima facie* case, then the Applicants are under no obligation to submit evidence of nonobviousness. MPEP § 2142.

Even if all of the features recited in the claim are known in the prior art, it is still not proper to reject a claim on the basis of obviousness unless there is a specific teaching, suggestion, or motivation in the prior art to produce the claimed combination. *Panduit Corp. v. Denison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ2d 1593 (Fed. Cir. 1987). *In re Newell*, 891 F.2d 899, 901, 902, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

The teaching, suggestion, or motivation to combine the features in prior art references must be clearly and particularly identified in such prior art to support a rejection on the basis of obviousness. It is not sufficient to offer a broad range of sources and make conclusory statements. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

It is respectfully submitted that the Action does not meet these burdens.

Declaration Pursuant To 37 C.F.R. § 1.131

Submitted herewith is a declaration pursuant to 37 C.F.R. § 1.131. Applicants have sworn behind both Downing (U.S. Patent 5,963,647) and Chang (U.S. Patent 5,884,288). Therefore, any rejection relying on either of these references has been rendered moot.

Downing does not constitute prior art

The recited invention has an earlier effective date than Downing. Downing refers to a provisional application having a February 14, 1997 date. However, the present invention is entitled to (and claims the benefit of) the November 27, 1996 filing date of provisional application 60/031,956. Thus, the Downing reference cannot constitute prior art with regard to the present invention.

Applicants "may overcome a 35 U.S.C. § 103 rejection based on a combination of references by showing completion of the invention by applicant prior to the effective date of any of the references; applicant need not antedate the reference with the earliest filing date" (MPEP § 715.02). Therefore, the rejections involving the Downing reference are not valid. All of the 35 U.S.C. § 103(a) rejections involve Downing. Thus, Applicants respectfully submit that the 35 U.S.C. § 103(a) rejections should be withdrawn.

The 35 U.S.C. § 103 Rejections Are Traversed

Applicants traverse these rejections on the grounds that Applicants' claims recite features which are neither disclosed nor suggested in the prior art, and because there is no teaching, suggestion, or motivation cited so as to produce Applicants' invention. The features recited in Applicants' claims patentably distinguish over the applied references.

As noted above, neither Downing nor Chang constitute prior art. All of the 35 U.S.C. § 103(a) rejections involve Downing and Chang. Nevertheless, even if it were somehow possible for Downing and Chang to constitute prior art, it still would not have been obvious to have produced the claimed invention.

The Action admits (e.g, page 3, last two lines) that Downing fails to disclose or suggest a browser. The Action also admits (e.g, page 7, lines 3-5) that Chang fails to disclose or suggest an automated banking machine. Neither reference teaches or suggests an automated banking machine with a browser.

In Chang a payor (202) may access the server (228) of an affiliated bank (206) (col. 4, lines 26-31; Figure 2). A payor's computer system includes a browser (314) which allows a payor (202) to view electronic bills (Figure 3). However, there is no indication that the bank (which admittedly lacks an automated banking machine) includes, or has any need of, a browser. Nor is there any teaching or suggestion of an automated banking machine's transaction function device being operative to carry out a transaction function responsive to a browser processing at least one document (e.g., claim 1). Nor would it have been obvious to have combined the references as alleged. Nor would the alleged modifications have produced the claimed invention. Therefore, it is respectfully requested that the 35 U.S.C. § 103(a) rejections be withdrawn.

Fees For Additional Claims

Please charge the fees associated with the submission of three (3) claims in excess of twenty claims (\$54) and any other fee due to deposit account 09-0428.

Versions With Markings To Show Changes Made

In the Specification

Paragraph beginning on Specification page 23, line 6 and ending on Specification page 23, line 13:

Returning to the sample transaction, in response to receiving the enable card reader message from the device application portion 84, the device server 92 is operative to generate a message through the intranet 16 to the device interfacing software portion 64 of the ATM 12. This message which comprises an HTTP record including instructions for operating the card reader, is directed to the IP port indicated 74 which is where the device interfacing software portion 64 communicates. In response to receiving this message, the software portion 64 is operative to send a message or messages on the control bus 50 which enables card reader mechanism 38 [34].

Paragraph beginning on Specification page 23, line 14 and ending on Specification page 24, line 2:

Continuing with the transaction as shown in Figure 6, the input of the card by the customer to the card reader 38 [34] is operative to cause the card data to be read and the device interfacing program portion 64 to send a message to the device server 92 indicating the card data has been read. This message is transmitted by the device server through the intranet 16 to the

device application portion 84. The device application portion then sends a message to the device server requesting the card data. The device server 92 transmits a message with instructions to deliver the card data from the device interfacing software portion 64 which responds with a message sending the card data through the intranet to the device server. The device server, if there is no basis for stopping the transaction, transmits an HTTP record including card data back through the intranet 16 to the device application portion 84.

Paragraph beginning on Specification page 70, line 10 and ending on Specification page 70, line 16:

Figures 28-30 include schematic depictions of examples of the operation of the keyboard mapper and the keypad applet. Figure 27 [29] shows an example of an input to the keypad 168. In this example the keypad applet 170 generally in response to instructions in an HTTP record such as an HTML document or other events, transmits and enables events to the transaction services application 146. In response a mapset is selected from the database 176 corresponding to the particular map name. The keyboard command server is further operative to enable the appropriate keys of the ATM.

Conclusion

Each of Applicants' pending claims specifically recite features and relationships that are neither disclosed nor suggested in any of the applied prior art. Furthermore, the prior art is devoid of any such teaching, suggestion, or motivation for combining features of the applied art so as to produce Applicants' invention. Allowance of all of Applicants' pending claims is therefore respectfully requested.

The undersigned will be happy to discuss any aspect of the Application by telephone at the Examiner's convenience.

Respectfully submitted,



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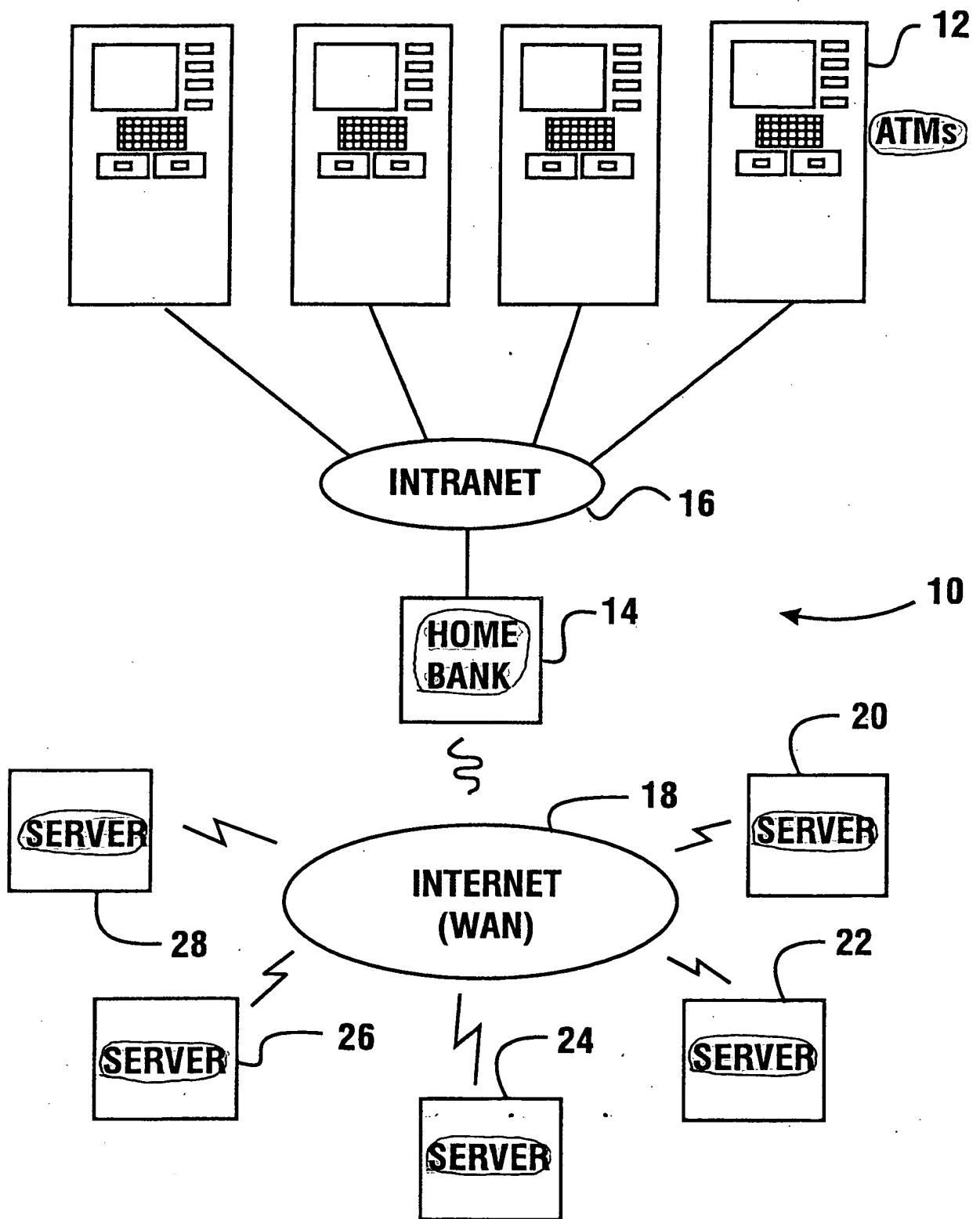
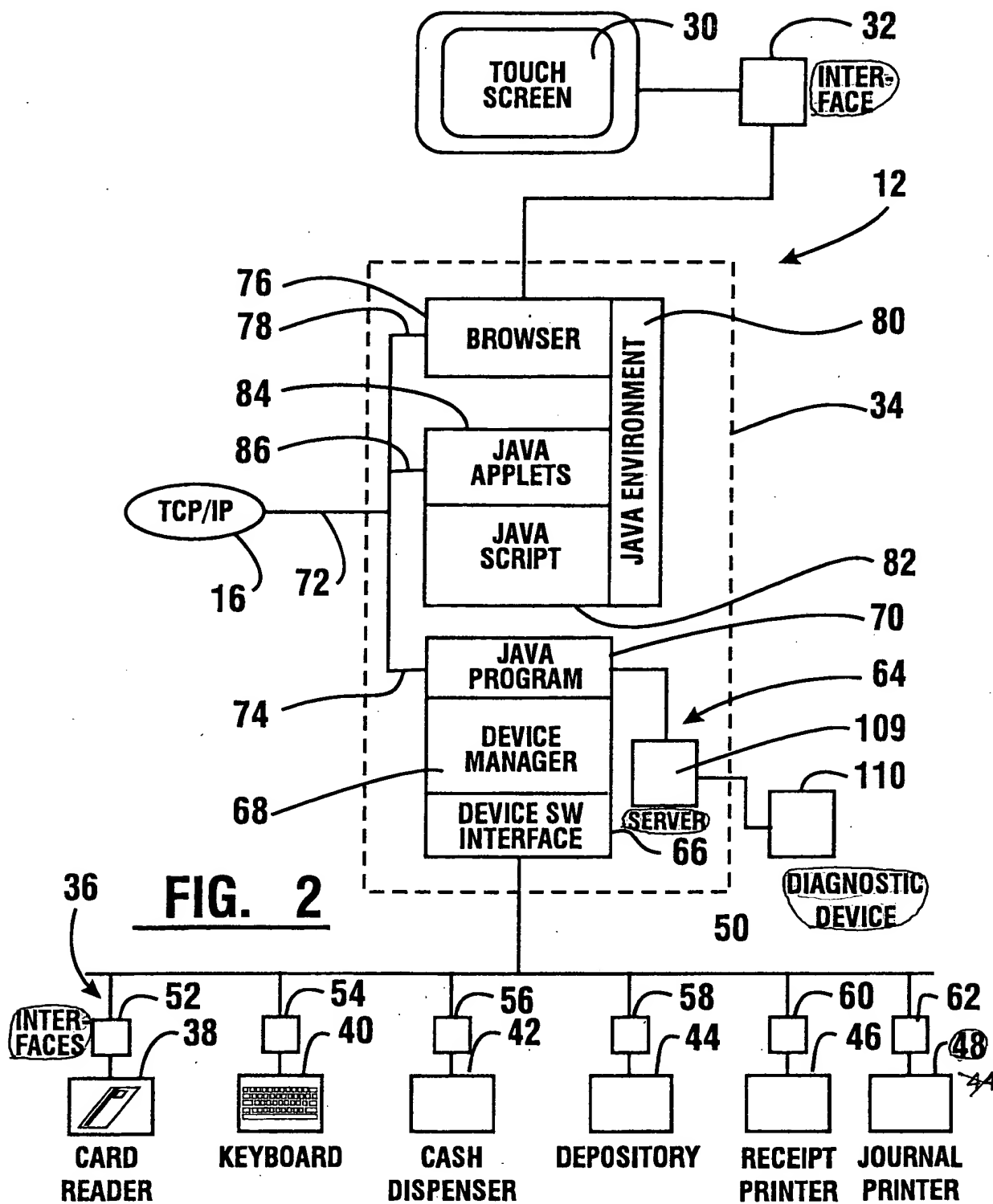
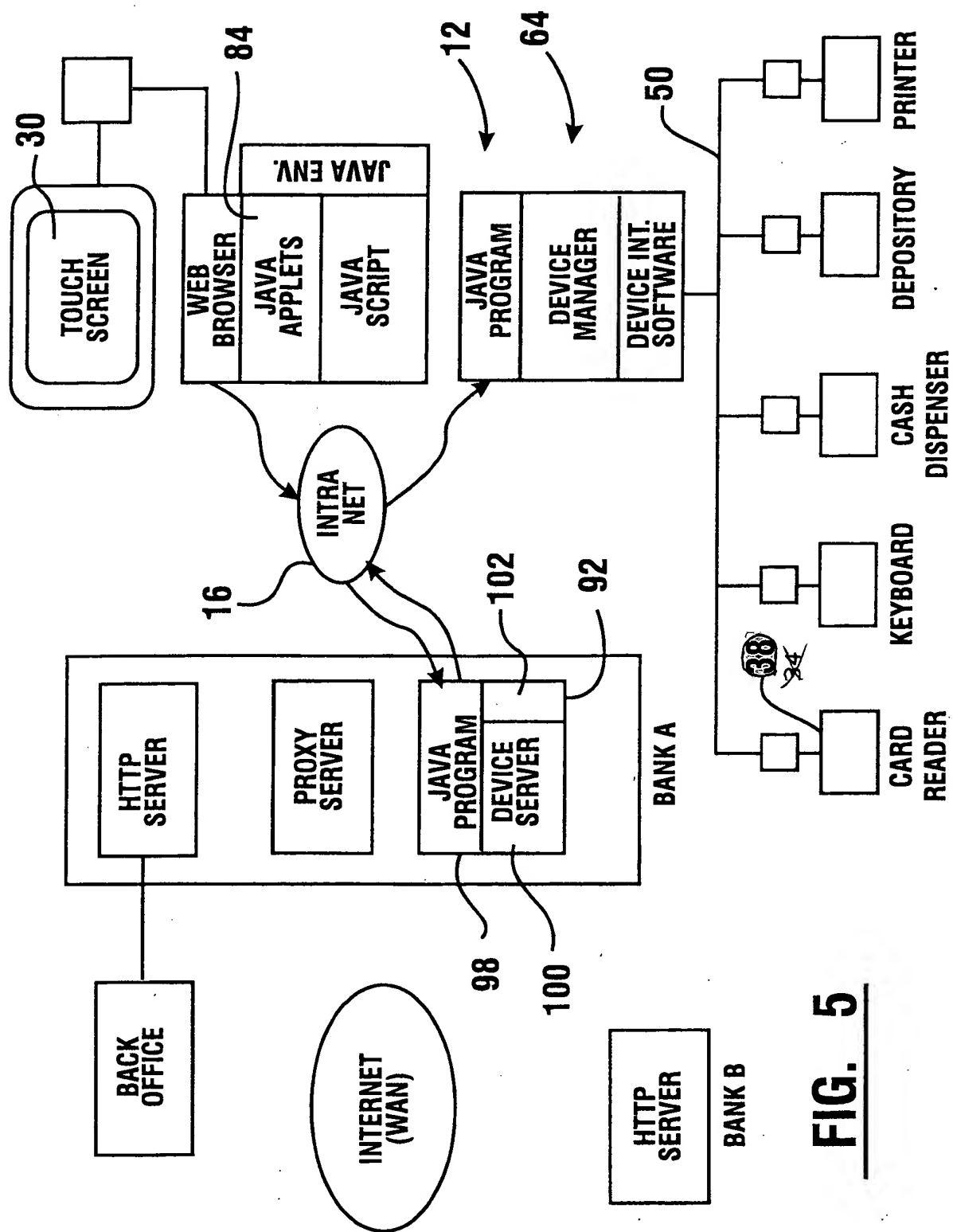


FIG. 1





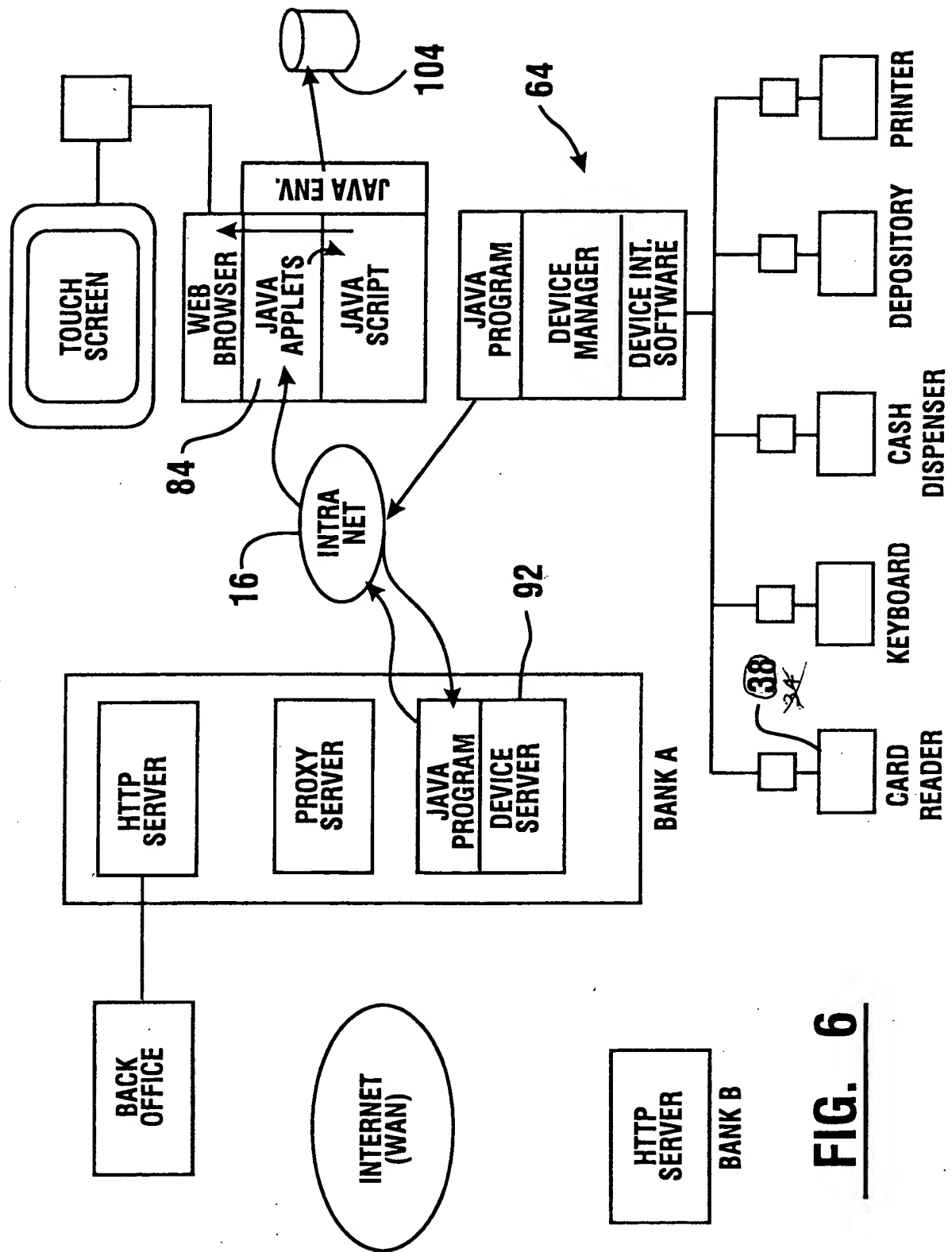


FIG. 6